

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 25-27, 46, 55, 57, 59, 69, and 71 are pending in the application, with claims 27 and 46 being the independent claims. Claims 66 and 70 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. Claims 46 and 59 are sought to be amended. Claim 46 has been amended to delete subject matter deemed to be outside the scope of the elected subject matter, compounds where R_3 is $-C(O)-CH_2-Z-G$. The claim has also been amended to clarify that the "alkylene" Marukush member for Z is an "unsubstituted alkylene." Claim 59 has been amended to correct a typographical error. These changes are believed to introduce no new matter, do not create new issues or require a new search. The changes are also believed to place the application in condition for allowance or in better form for appeal. Their entry is respectfully requested.

Based on the above proposed amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

I. Indication of Allowable Subject Matter

Applicants gratefully acknowledge the indication that claims 27 and 59 are allowed, and that claims 26 and 69 include allowable subject matter.

II. Status of the Application

The Examiner stated the claims were “examined to the extent they read on the elected species and variants thereof (i.e., compounds wherein R_3 is $-C(O)-CH_2-O-D$ or $-C(O)-CH_2-Y'-Z-G$).” Office Action ¶ 2. Additionally, the Examiner stated “[c]laims 66 and 70 stand withdrawn from further consideration as being drawn to a nonelected invention.” *Id.*

Applicants respectfully disagree with the Examiner’s analysis and conclusions. However, in the interest of advancing prosecution of the application, claim 46 has been amended to exclude compounds wherein R_3 is $-C(O)-CH_2-Z-G$. Additionally, claims 66 and 70 have been canceled. Applicants reserve the right to file a divisional application relating to the canceled subject matter.

III. Rejection under 35 U.S.C. § 102(b) over Phillipps et al.

Claims 25, 46, 55, 57, and 71 were “rejected under 35 U.S.C. § 102(b) as being anticipated by Phillipps et al. (‘569).” Office Action, ¶ 9. The Examiner stated

Phillipps et al. teach steroids of the 5α -pregnane series possessing a 3α -hydroxy group, an 11-oxo group, a 17α -hydrogen atom, a 20-oxo group and a group of formula $-XR$ at the 21-position. The reference teaches the preferred compounds are those wherein XR is an $-OC(O)R$ group and R is pyridyl. The reference teaches the compounds possess anaesthetic properties. The compounds and compositions taught by the reference are encompassed by the instant claims.

Id. (internal citations omitted).

Solely in the interest of advancing the prosecution of this application, Applicants amended claim 46 to recite that “Z group is unsubstituted alkylene, alkenylene, or alkynylene.” The compounds of independent claim 46 and dependent claims 25, 55, 57, and 71 are not steroids of the 5α -pregnane series possessing a 3α -hydroxy group, an 11-oxo group, a 17α -hydrogen

atom, a 20-oxo group and a group of formula -XR at the 21-position, wherein -XR is an -OC(O)R and R is pyridyl. As such, the rejection is rendered moot.

Applicants respectfully submit the Examiner's stated grounds for rejection has been rendered moot and should be withdrawn.

IV. Other Matters

The Examiner stated claim 59 contains a typographical error. Applicants have amended claim 59 according to the Examiner's helpful suggestion.

The Examiner also stated "[c]laims 26 and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if written in independent form including all of the limitations of the base claim and any intervening claims." It is Applicants' position that in light of the amendments to claim 46, claims 26 and 29 are no longer dependent upon a rejected base claim and are therefore allowable as presented.

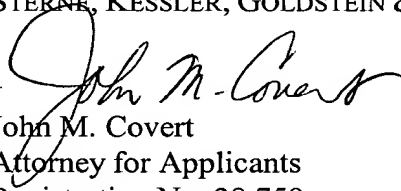
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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